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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,306	07/14/2003	Larry T. Palmer	284BOT/US93	7547
22875	7590	04/13/2005	EXAMINER	
GERALD W SPINKS P. O. BOX 2467 BREMERTON, WA 98310			SMITH, MATTHEW J	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,306

Applicant(s)

PALMER ET AL.

Examiner

Matthew J. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>15Oct03 & 12Feb04</u> . | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins (4817725) in view of Liady (1491610).

Jenkins discloses an apparatus for cutting a longitudinal member W run external to a tubular conduit S in a well bore comprising: a cutter body T attachable to a tubular conduit S in a fixed longitudinal position relative to the tubular conduit; and a cutter 12 mounted to the cutter body, the cutter being adapted to fasten to a longitudinal member W external to the tubular conduit S ("wrapped", col. 7, line 52), in a fixed longitudinal position relative to the external longitudinal member.

The reference also discloses a method for cutting a longitudinal member W run external to a tubular conduit S in a well bore comprising: attaching a cutter body T to a tubular conduit S being run into a well bore, the cutter body being attached in a fixed longitudinal position relative to the tubular conduit; fastening at least one cutter to a longitudinal member being run into the well bore external to the tubular conduit ("wrapped", col. 7, line 52); and cutting the tubular conduit below the cutter body;

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This reference does not disclose a cutter knife slidably mounted to the cutter body, the cutter knife being adapted to fasten to a longitudinal member external to the tubular conduit, a surface on the cutter body oriented to slidably abut the cutter knife and to force the cutter knife through the external longitudinal member upon lifting of the cutter body relative to the cutter knife, a plurality of the cutter knives located on opposing sides of the external longitudinal member, or a passage through the cutter body located to position the external longitudinal member adjacent a cutting edge of the cutter knife.

Liady presents a cutter knife 16 slidably mounted to the cutter body; the cutter knife being adapted to fasten to a longitudinal member external to the tubular conduit; a surface 5 on the cutter body oriented to slidably abut the cutter knife and to force the cutter knife through the external longitudinal member upon lifting of the cutter body relative to the cutter knife; a plurality of the cutter knives 14, 16 located on opposing sides of the external longitudinal member; and a passage 8 through the cutter body located to position the external longitudinal member adjacent a cutting edge of the cutter knife.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to cut the wireline W in Jenkins with the structure of Liady since both devices are designed to sever a cable downhole and therefore considered functional equivalents.

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Allowable Subject Matter

Claims 5-7 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 703-305-5135 or 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

MJS *MSS*
11 February 2005